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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/428,228	10/27/1999	FIROOZ GHASSABIAN	676-8CIP	4391

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EXAMINER
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RAMOS FELICIANO, ELISEO

ART UNIT	PAPER NUMBER
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2687

DATE MAILED: 11/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/428,228

Applicant(s)

GHASSABIAN, FIROOZ

Examiner

Eliseo Ramos-Feliciano

Art Unit

2687

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 26 and 28-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26 and 28-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 24, 2005 has been entered.

### *Drawings*

2. The drawings were received on October 24, 2005. These drawings are acceptable.

### *Claim Rejections - 35 USC § 112*

3. Previous rejection to *claims 26, and 32-36* under 35 USC § 112, second paragraph, is withdrawn in view of Applicant's amendment filed on October 24, 2005. *Claims 42-43* are still rejected because the amendment introduced a new deficiency as explained below.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claims 42-43** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. **Claim 42** recites the limitation "said keypad unit" in line 2. There is insufficient antecedent basis for this limitation in the claim. Since the keypad unit appears in claim 40, it appears the claim should be dependent from claim 40 instead.

7. **Claim 43** recites the limitation "said display unit" in line 2. There is insufficient antecedent basis for this limitation in the claim. Since the display unit appears in claim 41, it appears the claim should be dependent from claim 41 instead.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 26, 29, 31, 34-35 and 40-41** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kita (US Patent Number 6,112,054) in view of Pequignet (US Patent Number 5,631,879).

Regarding **claim 26**, Kita discloses a wrist-mounted communication device (wrist watch – Figures 30-31) for attaching to a wearer's wrist (column 39, lines 47-49), the device comprising:

an antenna system (141) having at least a first section (142) coupled to said device and configured to transmit and receive communication signals (column 40, lines 3-6), said wrist mounted communication device having an openable cover (118 – column 39, line 57) and said antenna system having a biasing mechanism (depicted in Figures 30-31) wherein said openable cover (118) of said wrist mounted communication device holds said first section of said antenna system (141) with said communication device in a horizontal plane position of said wrist-mounted communication device when said device is not in use by a user (for example, closed position), said biasing mechanism, when said openable cover is opened (open position),

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automatically releases said first section of said antenna system out of said communication device to a desired position away (see for example Figure 31) from said horizontal plane when said wrist communication device is in use by said user.

However, Kita fails to specify that the biasing mechanism releases said first section of said antenna system to the desired position "automatically" as claimed. For example, by automatically opening cover 118. Given that Kita's antenna 141 is included with the cover 118, by automatically opening the cover, the antenna would be released to the desired position automatically.

In the same field of endeavor, Pequignet discloses a wrist watch (Figure 5) having an openable cover (30) and a biasing mechanism (spring 34, 35) for automatically opening the cover upon pressing a button (60). See abstract, and column 3, lines 44-46. One advantage of Pequignet's invention is to make it easier for the user to open the cover and make it more attractive for sales.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to automatically open Kita's cover by applying Pequignet's teachings because this would make it easier for the user to open the cover and more attractive for sales.

Regarding **claims 29 and 40-41**, Kita and Pequignet disclose everything claimed as applied above (see *claim 26*). In addition, Kita discloses that the wrist-mounted communication device further comprises a watch unit (column 39, line 48-50), a keypad (117 – Figure 30), and a display (118 – Figure 30). Pequignet also discloses a watch unit (abstract, Figure 5).

Regarding **claim 31**, Kita and Pequignet disclose everything claimed as applied above (see *claim 26*). However, they fail to specify the particular materials used to manufacture the back of the openable cover and the external part of the wrist-mounted communication device.

The examiner contends that the particular materials used to manufacture the subject product would be a choice of engineering design that would consider esthetical impact in order to make the product more attractive to buyers.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to make the best engineering design choice to use appropriate materials as claimed for the advantage of making the product more attractive to buyers.

In addition, Kita indirectly discloses that when said openable cover is positioned on said wrist communication device, the entire communication device appears in a uniformly integrated arrangement (Figures 30-31 show cover 118 in open position; it is not difficult to figure out how it looks in closed position).

Regarding **claim 34**, Kita and Pequignet disclose everything claimed as applied above (see *claim 26*). In addition, Kita discloses at least a second section (antenna section 124, keypad 117, or LCD 156) configured to operate independently from said first section (141) of said antenna system.

Regarding **claim 35**, Kita and Pequignet disclose everything claimed as applied above (see *claim 34*). However, they fail to specify that the first and second sections of said antenna system can operate as a diversity antenna.

The examiner contends that diversity is well known for improved signal quality. Given the fact Kita already teaches two distinct antennas, it would have been obvious to a person of

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ordinary skill in the art at the time the invention was made to operate them as a diversity antenna for the advantage of better communication quality.

10. **Claims 28 and 38-39** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kita in view of Pequignet as applied to *claim 26, 29 respectively*, above, and further in view of Seymour (US Patent Number 6,529,713).

Regarding **claim 28**, Kita and Pequignet disclose everything claimed as applied above (see *claim 26*). However, they fail to specifically disclose that the openable cover is a removable handset of said wrist-mounted communication device as defined by applicant.

In the same field of endeavor, Seymour discloses a wrist-mounted communication device (radio handset – Figure 6) including an openable cover (6 and 7) that is a removable handset (column 5, lines 5-9). One advantage of Seymour is to allow the user to place the headset closer to the ear in a more comfortable manner.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to make the openable cover a removable handset of the wrist-mounted communication device because this would allow the user to place the headset closer to the ear in a more comfortable manner.

Regarding **claims 38-39**, Kita, Pequignet and Seymour disclose everything claimed as applied above (see *claims 28 and 29 respectively*). In addition, Seymour discloses that the handset is a multi-sectioned handset (fairly characterized as “multi-sectioned keypad” too) comprising at least two sections (section 6 and section 7) configured to move between a closed position and an open position (Figure 6), wherein in closed position said multi-sectioned handset

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is adapted to be as small as the largest section, and wherein in open position said sections of said multi-sectioned handset expand to provide an extended handset (Figure 3).

11. **Claims 30 and 42-43** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kita in view of Pequignet as applied to *claims 29, 40 and 41 respectively*, above, and further in view of Kivelä (US Patent Number 6,529,713).

Regarding **claims 30 and 42-43**, Kita and Pequignet disclose everything claimed as applied above (see *claims 29, 40 and 41 respectively*). However, they fail to specifically disclose that while attached to said wrist-mounted communication device, said cover and said watch unit are in opposite relationship on a user's wrist as defined by applicant. Nor that the keypad unit and the watch unit are in opposite relationship on a user's wrist. Nor that the display unit and the watch unit are in opposite relationship on a user's wrist.

In the same field of endeavor, Kivelä discloses a wrist-mounted communication device including a wrist-mounted communication device (Figure 2), with a cover (20 – keypad/display units) and a watch unit (opposite side) in opposite relationship on a user's wrist (column 3, lines 20-21; column 4, lines 19-20). Alternatively, the cover (Figure 8b) and the watch unit (8a) are in opposite relationship on a user's wrist (note fingers in the figures). One advantage of Kivelä's invention is to improve antenna efficiency (column 6, lines 43-52).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to place the cover (keypad/display) and the watch unit in opposite relationship on a user's wrist as suggested by Kivelä because this would help to improve antenna efficiency as taught by Kivelä.



12. **Claims 32-33 and 36-37** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kita in view of Pequignet as applied to *claims 26 and 34 respectively*, above, and further in view of Houlihan (US Patent Number 5,467,324).

Regarding **claim 32**, Kita and Pequignet disclose everything claimed as applied above (see *claim 26*). However, they fail to specifically disclose that the antenna system is expandable in its open position.

In the same field of endeavor, Houlihan discloses a wrist-mounted communication device including a cover (336 – Figure 9) that is expandable in its open position (column 5, lines 22-27). One advantage of Houlihan's invention is to better direct antenna radiation away from the user's head.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to make the antenna system expandable in its open position because this would help to better direct antenna radiation away from the user's head.

Regarding **claim 33**, Kita, Pequignet and Houlihan disclose everything claimed as applied above (see *claim 32*). In addition, Houlihan discloses an expansion antenna (part 332) configured to rotate about said first section of said antenna system (see Figure 9; column 5, lines 22-27).

Regarding **claims 36-37**, Kita and Pequignet disclose everything claimed as applied above (see *claim 34*). However, they fail to specifically disclose that one end of said first section of said antenna system is coupled to said communication device and the other end of said first section of said antenna system is rotatably coupled to one end of said second section of said antenna system. Or that one end of said first and second antenna is rotatably coupled to said

communication device such that said first and second antennas are adjustable to form an angle in relation to each other.

In the same field of endeavor, Houlihan discloses a wrist-mounted communication device including a cover (336 – Figure 9) that includes an antenna structure, so that that one end of the first antenna (see Figure 9; column 5, lines 22-27) is coupled to the communication device and the other end of the first antenna is rotatably coupled to one end of the second antenna (part 332). Also one end of the first and second antenna is rotatably coupled to the communication device such that the first and second antennas are adjustable to form an angle in relation to each other. One advantage of Houlihan's invention is to better direct antenna radiation away from the user's head.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to implement the described configuration because this would help to better direct antenna radiation away from the user's head.

### ***Response to Arguments***

13. Applicant's arguments filed October 24, 2005 have been fully considered but they are not persuasive.

14. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the antenna element is completely hidden when the cover is closed – page 8, second full paragraph) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

15. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., not biasing the cover – page 9, first full paragraph) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The claimed language does not require the antenna and the cover be separate/unattached as Applicant appears to argue.

16. Applicant argues that the antenna of the applied prior art "does not release out of the device" (page 9, second full paragraph).

In response, the claimed language does not distinctively define "out of" as to distinguish from the applied prior art.

17. In response to applicant's argument that there is no suggestion to combine the references (page 10, lines 1-4), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, the teaching, suggestion, or motivation to combine is found in the knowledge generally available to one of ordinary skill in the art. For example, to make it easier for the user to open; therefore, more attractive to sell/buy.

#### ***Conclusion***

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18. Any inquiry concerning this communication from the examiner should be directed to Eliseo Ramos-Feliciano whose telephone number is 571-272-7925. The examiner can normally be reached from 8:00 a.m. to 5:30 p.m. on 5-4/9 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester G. Kincaid, can be reached on (571) 272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**ELISEO RAMOS-FELICIANO**  
**PATENT EXAMINER**

ERF/erf

November 11, 2005